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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/939,896	08/27/2001	Lane W. Lee	M-12042 US	4074

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EXAMINER

BAYAT, BRADLEY B

ART UNIT	PAPER NUMBER
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3621

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/23/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/939,896

Applicant(s)

LEE ET AL.

Examiner

Bradley B. Bayat

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 36-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 36-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Status of Claims

This communication is in response to amendment and remarks filed on November 29, 2006.

- Claim 36 has been amended.
- Claims 1-35 and 41-43 were previously cancelled.
- Claims 36-40 remain pending.

Response to Arguments

The examiner has withdrawn the rejection under 112 1st paragraph in light of the amendment.

The examiner has further withdrawn the rejection detailed in the previous action under 112 2nd paragraph, however, Applicant(s) are reminded that optional or conditional elements do not narrow the claims because they can always be omitted. See *e.g.* MPEP §2106 II C:

“Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.

[Emphasis in original.]”; and *In re Johnston*, 435 F.3d 1381, 77 USPQ2d 1788, 1790 (Fed. Cir.

2006) (“As a matter of linguistic precision, optional elements do not narrow the claim because they can always be omitted.”). “As a matter of linguistic precision, optional elements do not

narrow the claim because they can always be omitted.” *In re Johnston*, 435 F.3d 1381, 77

USPQ2d 1788, 1790 (Fed. Cir. 2006)(where the Federal Circuit affirmed the Board’s claim

construction of “further including that said wall may be smooth, corrugated, or profiled with

increased dimensional proportions as pipe size is increased” since “this additional content did not

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narrow the scope of the claim because these limitations are stated in the permissive form 'may.'").

Applicant's arguments filed on 11/29/06 have been fully considered but they are not persuasive. Applicant's argument distinguishing the host device of the claimed invention from the cited reference is unpersuasive, especially since Applicant notes such a host device may be a personal computer (response p. 4) or "any physical device that embeds an engine (spec. p. 22, line 28)."

Nanoka discloses:

[0462] Thereafter, in step S36-6, the signature processor 189 checks the integrity of the signature data SIG.sub.K1,ESC within the key file KF shown in FIG. 3B, i.e., the integrity of the creator of the key file KF, by using the public key data K.sub.ESC,P read from the storage unit 192, and also checks whether the key file KF is registered in the EMD service center 102.

Nonaka anticipates applicant's amendment of "establishing a secure session by transmitting a session key to the host device" in that it can be mutually authenticated utilizing a session key each time [0427-0444].

Claim Rejections - 35 USC § 112, 2nd paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 39 recites the limitation "the revocation file" in line 2 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b); by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 36-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Nonaka et al. (hereinafter Nonaka), US 2003/0046238 A1.

As per the following claims, Nonaka discloses:

36. A method of revoking a host device on a file-by-file basis, comprising:

- receiving at a storage engine a certificate from the host device, the certificate containing a digital signature (§435, 462-494);
- authenticating the digital signature (§22-28, 54-66; figures 60, 61 and associated text);
- establishing a secure session by transmitting a session key to the host device (§427-444); and during the secure session:
- receiving at the storage engine a file request from the host device, the file request being directed to a file stored on a storage medium accessible to the storage engine (§435, 671-675);
- reading a revocation list associated with the file from the storage medium, the revocation list containing at least one rule, the at least one rule associating data in the revocation list with data in the certificate (§435, 671-675);

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- applying the at least one rule on the data in the revocation list and the associated data in the certificate (§247); and
- if the application of the at least one rule provides a failing result, denying the file request (§671-675; figures 60-61).

37. The method of claim 36, wherein the at least one rule comprises a plurality of rules (§247, 857, 1085-1087).

38. The method of claim 36, wherein the storage medium is an optical disk (§221).

39. The method of claim 36, wherein the application of the at least one rule act comprises matching the data in the revocation file with the data in the certificate (§225, 256, 283).

40. The method of claim 36, further comprising: if the application of the at least one rule provides a successful result, granting the file request (§262-276; 359-370).

41. CANCELED.

42. CANCELED.

43. CANCELED.

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Although the Examiner has pointed out particular references contained in the prior art(s) of record in the body of this action, the specified citations are merely representative of the teachings in the art as applied to the specific limitations within the individual claim. Since other passages and figures may apply to the claimed invention as well, it is respectfully requested that the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

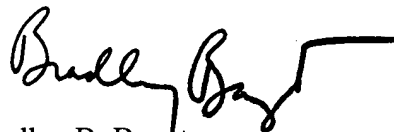
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley B. Bayat whose telephone number is 571-272-6704. The examiner can normally be reached on Tuesday-Friday 8 a.m.-6:30 p.m..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on 571-272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Bradley B. Bayat
Primary Examiner
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